The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS M. HILTON, MICHAEL D. MORGAN,
MICHAEL WINDSOR SYMONS, and TIMOTHY MICHAEL SYMONS

Appeal 2006-2681
Application 10/044,407
Technology Center 1700

Decided: September 28, 2006

Before KIMLIN, JEFFREY T. SMITH, and FRANKLIN, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Appellants appeal the Examiner's final rejection of claims 1, 5 to 8, 10, and 11. Because the issues are not ripe for appeal, we remand.

On page 9 of the Brief, Appellants refer to the "Hilton Declaration." The Examiner on page 8 of the Answer indicates that the substance of this declaration has been considered. Appellants' Appeal Brief filed January 23, 2006 does not include a copy of this document. It is noted that Appellants' Brief as filed did not include an Evidence Appendix. To remedy this

deficiency in the Brief, Appellants on July 12, 2006 filed a letter indicating, "no evidence has been submitted in support of this appeal." As such, Appellants did not include a copy of the declaration referenced in the Brief.

A Declaration filed October 1, 2004 is part of the official Image File Wrapper (IFW) for this application. However, it is not clear whether Appellants intended to include a new declaration with the Brief or rely on the declaration filed October 1, 2004.

In order for the merits panel of the Board of Patent Appeals and Interferences (BPAI) to review the record on appeal, the document relied upon must be properly identified and referenced. It is important that the record presented to the BPAI for consideration be the same as the record established by the Examiner and the Appellants. A meaningful review of this record cannot occur unless all of the documents submitted by Appellants for consideration have been adequately presented into the Appeal record.

The Examiner has relied on the SU 1743887-A1 reference as evidence of obviousness. A close inspection of the record reveals that only a Derwent Abstract of this document is present. This abstract of the SU 1743887-A1 reference is not proper for a determination of patentable subject matter by the BPAI. It is noted that the Appellants on pages 6 to 9 of the Brief discuss the contents of this cited document. However, the abstract presented does not include the full details of the underlying document. The Examiner is instructed to obtain the full SU 1743887-A1 document.[1] Upon receipt of this document, the Examiner should reevaluate the relevance of the entire

[1] The Examiner should translate this document to the English language if necessary.

document obtained and the suitability of including this document in the rejection.

The BPAI is a Board of review and not a vehicle for initial examination. *See* 35 U.S.C. § 6(d)(2000). The burden is on the Examiner to set forth a prima facie case of obviousness. *See In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). Findings of facts and conclusions of law must be made in accordance with the *Administrative Procedure Act*, 5 U.S.C. § 706(a) (E)(1994). *See Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S. Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999). Findings of fact relied upon in making the obviousness rejection must be supported by substantial evidence within the record. *See In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

In light of the above facts, we feel that it is premature to decide the issues in this appeal. More fact finding needs to be completed on this record by the Examiner in view of the full SU 1743887-A1 reference.

CONCLUSION

In summary, the instant application is remanded to the Examiner to consider the aforementioned issues and act accordingly.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1)(2004) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REMANDED

JTS:hh

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